

Patent-US 211C1  
Edwards Ref: RMI-5734CON  
(formerly 267/177)

### REMARKS

Reconsideration of the rejections set forth in the Office Action mailed June 7, 2004, is respectfully requested. Claims 1 and 3 have been amended. Claim 1 has been amended to require that force is applied distally to the release. The other amendments to claim 1 are made to improve clarity and are not made for reasons related to patentability. Claims 5-12 were canceled. Claims 13-16 have been newly added. Claims 1-4 and 13-16 remain pending in this case. Support for these amendments can be found in the original specification at, e.g., page 14, line 22 – page 15, line 13; page 16, line 18 – page 17, line 11. Therefore, these amendments were made without the addition of new matter.

### Restriction

As stated in a voicemail from Diane Wong on May 28, 2004, Applicants hereby elect the claims in Group I, drawn to an obturator. Claims 5-12 have been canceled without prejudice to their continued prosecution in a later application.

### Claim Objections

As suggested, the informality of claim 1 has been corrected by inserting “obturator” after “an” in line 1.

### 35 U.S.C. § 112

Claim 3 was rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter that applicants regard as the invention. In particular, “the actuating member” allegedly lacks

Patent US 211C1  
Edwards Ref: RMI-5734CON  
(formerly 267/177)

antecedent basis. Applicants have amended the claim to recite "the actuating mechanism," which has antecedent basis is claim 1, line 6.

#### Art Rejections

Claims 1, 2, and 4 are rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by Gordin (U.S. Patent No. 3,885,308). Applicants have amended claim 1 to specify that, in order to retract the blade, "*a force is applied distally to the release.*" The '308 patent does not teach or suggest all of the limitations of claim 1 as amended. As described by Gordin, to release the knife tool, "it is only necessary to initially manually pull in a rearward [proximal] direction on the actuating member." (Col. 3, lines 26-29, emphasis added). Claims 2-4 depend from claim 1 and are therefore patentably distinct from the prior art for the same reasons stated above.

Applicants have also added new claims 13-16. Claim 13 requires that "*a force applied to the release slideably rotates the rotary element from a position in which the rotary element and the release are engaged to a position where the release is disengaged from the rotary element.*" The '308 patent does not teach or suggest all of the limitations of claim 13. As seen in Fig. 5 and accompanying text (Col. 2, line 39 – Col. 3, line 16), the device described by Gordin does not describe rotary elements that are in positions where the rotary elements and release are disengaged when the knife is advanced. In contrast, in the mechanism described by Gordin, the rotary elements and the release are always engaged. "As illustrated in FIG. 5, this movement of the tool carrying member 19 by the actuating member 6 takes place through the ball members 36 which, during this forward movement, are clamped between the rear section 33 of the actuating member extension 17 and the rear end section 18 of the tool carrying member 19." (Col. 2, lines

Patent US 211C1  
Edwards Ref: RMI-5734CON  
(formerly 267/177)

56-62) Claims 14-16 depend from claim 13 and are therefore patentably distinct from the prior art for the same reasons stated above.

Therefore, applicants respectfully request withdrawal of the rejections and reconsideration of the claims as amended and the newly added claims.

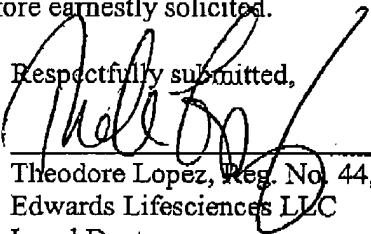
Allowable Subject Matter

Applicants gratefully acknowledge the examiner's indication that claim 3 would be allowable if rewritten to overcome the § 112 rejection and in independent form including all of the limitations of the base claim and any intervening claims.

For all the foregoing reasons, Applicants assert the claims are in condition for allowance. Favorable action on the merits of the claims is therefore earnestly solicited.

Dated: September 7, 2004

Respectfully submitted,

  
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